

## **REMARKS**

At the time the Official Action was mailed, claims 1-37 were pending. Claims 1, 3, 13, 14, 23 and 26 have been amended to set forth the recited subject matter more clearly. Reconsideration of the claims, as amended, in view of the remarks set forth below is respectfully requested.

### **Rejections Under 35 U.S.C. § 102**

The Examiner rejected claims 1-4, 6, 8, 10, 11, 13-15, 18, 19, 23, 26, 27 and 29-31 under 35 U.S.C. § 102(e) as being anticipated by Bailis et al. (U.S. Pat. No. 6,434,652). The Examiner's rejections are too lengthy to be reproduced efficiently herein. Nonetheless, Applicants respectfully traverse these rejections.

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

The present application is directed to a control circuit which controls the application of power from a power rail of the main unit of a system to a power rail of a peripheral device being hot-plugged into the system. Page 7, lines 17-20. The disclosed control circuit addresses a number of problems associated with hot plug capabilities. Page 7, lines 17-18;

see page 7, lines 1-15. Advantageously, the control circuit is configured to gradually apply power to the peripheral device to reduce the current surge that may occur from connecting a peripheral device to the main unit. Page 9, lines 16-21; page 10, lines 5-8. Further, the control circuit is configured to monitor the voltage applied to the peripheral device and to enable access to the peripheral device once the voltage reaches a predetermined threshold to ensure that the peripheral device will operate properly. Page 8, lines 4-20; page 10, line 10 – page 12, line 4. Still further, the control circuit is configured to filter high frequency noise from being delivered from the main unit to the peripheral device during the gradual application of power to the peripheral device. Page 8, line 22.– page 9, line 3; page 9, lines 21 –23.

Accordingly, independent claims 1 and 23, as amended, recite a control circuit comprising “a first plurality of devices configured to gradually apply power to the peripheral device,” and “a second plurality of devices configured to monitor voltage applied to the peripheral device from the power supply and to enable access from the processor-based device to the peripheral device when the voltage reaches a predetermined threshold.” Similarly, independent claim 13 recites “gradually applying power from the processor-based device to the peripheral device in response to detecting connection,” “monitoring voltage applied to the peripheral device while gradually applying power,” and “enabling access from the processor-based device to the peripheral device when the monitored voltage reaches a predetermined threshold.” Further, dependent claims 3, and 26 have been amended to recite that the first plurality of devices “comprise one or more high frequency filters.” Dependent claim 14 has been similarly amended to recite “filtering noise from being delivered from the processor-based device to the peripheral device.”

In contrast, the Bailis reference does not disclose a control circuit comprising a first plurality of devices configured to *gradually* apply power to the peripheral device *and* a second plurality of devices configured to monitor voltage applied to the peripheral device from the power supply and to enable access from the processor-based device to the peripheral device when the voltage reaches a predetermined threshold. Further, the Bailis reference does not disclose a control circuit comprising one or more high frequency filters. Accordingly, the Bailis reference does not disclose all of the elements recited in the present claims.

Because the Bailis reference *does not* disclose each of the elements recited in the present claims, the Bailis reference cannot possibly anticipate the claimed subject matter. Therefore, Applicants respectfully request withdrawal of the Examiner's rejections under 35 U.S.C. § 102 and allowance of claims 1-4, 6, 8, 10, 11, 13-15, 18, 19, 23, 26, 27 and 29-31.

### **Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Park (U.S. Pat. No. 6,308,233) in view of Bailis. Further, the Examiner rejected claims 5, 7, 9, 12, 20-22, 28 and 32-37 under 35 U.S.C. § 103(a) as being unpatentable over Bailis in view of Falkenburg et al. (U.S. Pat. No. 6,434,652). Finally, the Examiner rejected claims 16, 17, 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Bailis in view of Clemo (U.S. Pat. No. 5,714,809). Applicants respectfully traverse these rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination.

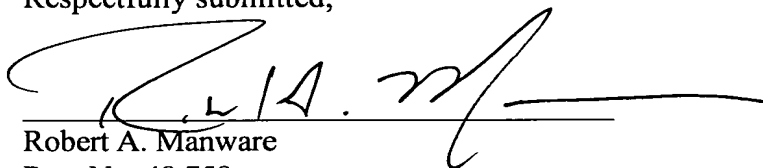
*ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

The rejected claims each depend from independent claims which, for the reasons set forth above, include subject matter which is not disclosed by the Bailis reference. Applicants note that independent claim 1 was also rejected based on Park, in view of Bailis. It appears that the Examiner is applying Park is the primary reference. However, as with Bailis, Park does not disclose a control circuit comprising a first plurality of devices configured to *gradually* apply power to the peripheral device *and* a second plurality of devices configured to monitor voltage applied to the peripheral device from the power supply and to enable access from the processor-based device to the peripheral device when the voltage reaches a predetermined threshold. As discussed above, Bailis does not disclose these features, either. Indeed, it appears that the Bailis reference is only being applied under 35 U.S.C. § 103(a) as disclosing a “processor-based device.” Regardless, because the Bailis reference does not disclose the features recited in claim 1, as discussed above, it cannot possibly cure the deficiencies of the Park reference. Applicants further note that neither the Falkenburg reference, nor the Clemo reference does cures the deficiencies discussed above with respect to the Bailis reference. Accordingly, Applicants submit that claims 1-3, 5, 7, 9, 12, 16, 17, 20-22, 24, 25, 28 and 32-37 cannot be rendered obvious by the cited combination and respectfully request withdrawal of the rejections under 35 U.S.C. § 103 (a).

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request withdrawal of the Examiner's rejections and allowance of claims 1-37. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. A. Manware', is written over a horizontal line.

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